

REMARKS

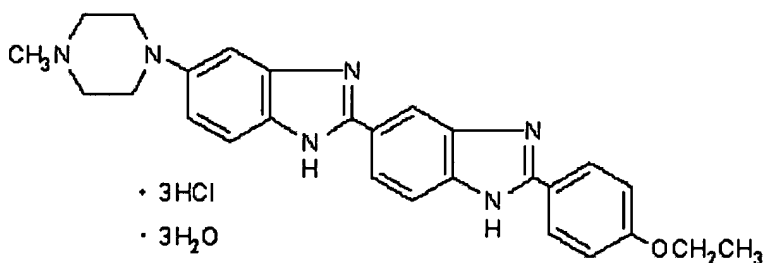
Applicant respectfully requests reconsideration. Claims 33, 34 and 44-46 were previously pending in this application. Claims 33, 45 and 46 have been amended. As a result, claims 33, 34 and 44-46 are pending for examination with claim 33 the sole independent claim. No new matter has been added.

Objections to the Specification

The Examiner objected to the use of the Trademark "Hoechst 3342" throughout the application. Applicant respectfully traverses the objection.

Applicant initially notes that Hoechst 3342 is a misspelling of Hoechst 33342. The specification has been amended to correct the typographical error.

Hoechst 33342 is not a trademark, but is a name for a well-known chemical compound that is routinely used to stain DNA and determine apoptosis. The chemical structure of Hoechst 33342 is shown below:



A search of the NCBI PubMed database using "Hoechst 33342" and "apoptosis" as the search terms found 380 references that mention this compound in combination with apoptosis. A search of the USPTO website patents database using "Hoechst 33342" and "apoptosis" as search terms yielded 113 patents. Examples of US patents are US 5,929,104 (see Example 1) and US 6,608,026 (see Example 16), which describe the use of Hoechst 33342 in staining cells for determining apoptosis.

Therefore, the use of Hoechst 33342 in the specification is not the use of a trademark, but rather is the use of a chemical compound name. Accordingly, withdrawal of this objection is respectfully requested.

Claim Objections

The Examiner objected to claim 45 for use of the term “[γ -³²]ATP”. Claim 45 has been amended to recite the term as suggested by the Examiner: “[γ -³²P-ATP”. Accordingly, withdrawal of the objection is respectfully requested.

Rejections Under 35 U.S.C. §112

1. The Examiner rejected claims 33, 34 and 44-46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses the rejection.

The Examiner acknowledged that the specification describes administering a compound (i.e., JNK inhibitor) to an animal and examining neuronal tissue for apoptosis, but suggests that the specification does not link the foregoing with the ability of the compound to prevent neuronal cell death. Applicant respectfully notes that the claims as amended no longer recite this feature, but rather recite a linkage between a decrease in apoptosis in the neuronal tissue sample and the compound's ability to specifically inhibit JNK kinase activity. Applicant contends that the amendment of the claims obviates the Examiner's rejection.

Applicant also notes that support for the method as now claimed is found in the specification as filed at page 17, lines 16-26. Contrary to the Examiner's reading of the specification, this passage quite clearly links screening for inhibitory agents with the analysis of apoptosis in the animal. The Examiner notes that the passage appears to be related to determining the safety of the JNK inhibitor (last paragraph on page 3 of the Office Action). Applicant respectfully disagrees. The relevant passage reads: “Preferably, the animal used is an example of a model system mimicking a neurological condition. However, to test the safety of the putative agent, a normal animal is preferably also subjected to the treatment.” (Page 17, lines 21-23, emphasis added). The specification clearly indicates that when safety is to be tested, a normal animal is tested in addition to the animal that is an example of a neurological disease

model. Therefore, safety testing is not the primary thrust of this passage; rather, the passage indicates that safety can be tested in parallel with testing JNK inhibitory activity and the effects of this on apoptosis.

Accordingly, withdrawal of the rejection of claims 33, 34 and 44-46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is respectfully requested.

2. The Examiner rejected claims 33, 34 and 44-46 under 35 U.S.C. § 112, first paragraph, as not enabled. Applicant respectfully requests reconsideration based on the amendment of claim 33.

The Examiner rejected the claims because they were drawn to methods for determining the ability of a compound to prevent neuronal cell death. Applicant amended claim 33 to recite that the methods are for determining the ability of a compound to specifically inhibit JNK kinase activity. The Examiner indicated that the specification supported a showing of a reduction in apoptosis as a result of a JNK inhibitor.

Accordingly, withdrawal of the rejection of claims 33, 34 and 44-46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is respectfully requested.

3. The Examiner rejected claims 33 and 46 under 35 U.S.C. § 112, second paragraph, as indefinite.

Claim 33 was rejected for the use of the phrase “a change in apoptosis in the neuronal tissue sample”, which the Examiner deemed indefinite. Applicant has changed the term such that a decrease in apoptosis in the neuronal tissue sample is recited.

Claim 46 was rejected for the use of the alleged trademark Hoechst 3342. As noted above, Hoechst 33342 (the correct spelling of the compound name) is not a trademark, but rather is the name of a specific chemical compound, the structure of which is shown above. The compound name is not indefinite in any way, as demonstrated by the numerous references to it in the scientific literature.

In view of the amendment of claim 33 and the argument pertaining to claim 46, Applicant respectfully requests that the Examiner withdraw the rejection of claims 33 and 46 as indefinite.

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CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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